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IN THE

Supreme Court of the United States

OCTOBER TERM, 1975

No. 75-310

SPERRY RAND CORPORATION,

Petitioner,

—v.—

DEERE & COMPANY,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

Petitioner Sperry Rand Corporation, Sperry New Holland Division ("New Holland"), respectfully prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Ninth Circuit in the above-entitled case.

OPINIONS BELOW

The opinion of the Court of Appeals is reported at 513 F.2d 1131, and is reprinted in the Appendix hereto, p. 1a, *infra.* The opinion of the District Court for the Eastern District of California is reported at 322 F. Supp. 397, and is reprinted in the Appendix, p. 8a, *infra* (hereinafter referred to as "App.").

JURISDICTION

The judgment of the Court of Appeals was entered on March 31, 1975. (App. 6a) A timely Petition for Rehearing and Suggestion for Hearing *En Banc* was denied on May 30, 1975. (App. 7a) The jurisdiction of this Court is invoked pursuant to 28 U.S.C. § 1254(1). The basis of jurisdiction in the District Court was 28 U.S.C. §§ 1338(a) and 2201.

QUESTIONS PRESENTED

As to the certiorari policy: Despite the constitutional basis of the patent system and its importance to the encouragement of technological innovation, this Court has considered the test for patentability under Section 103 of the Patent Act on precisely two occasions[1] in the twenty-three years since its enactment in 1952. The Court's failure to involve itself in this area, coupled with the fact that many lower courts and commentators have viewed the Court's two major decisions since 1952 as inconsistent,[2] has led the various Courts of Appeals to differ greatly, not only

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[1] October Term, 1969: *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969); and October Term, 1965: *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966) (decided together with *Calmar, Inc.* v. *Cook Chemical Co.* in the same opinion); and *United States* v. *Adams*, 383 U.S. 39 (1966). (The *Graham, Calmar* and *Adams* cases—sometimes called the *Graham-Calmar-Adams* trilogy—were argued before the Court one after the other and decided the same day in two related opinions.)

[2] *E.g.*, D. Dunner, J. Gambrell, and I. Kayton, *1969-70 Annual Review*, Patent Law Perspectives, Rel. No. 10 at A.1[1]-1 (1970) (hereinafter cited as *1969-70 Annual Review*); Note, *After Black Rock: New Tests of Patentability—The Old Tests of Invention*, 39 Geo. Wash. L. Rev. 123 (1970).

in verbal formulation but also in practical result, as to the correct standard of patentability under Section 103. Should not the Court resolve this confusion by granting certiorari in this case wherein the Ninth Circuit has applied a test under Section 103 which no combination patent for machinery can ever satisfy and which conflicts with the test applied by the Second, Fifth, Tenth, and District of Columbia Circuits?

On the merits: Relying upon *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950), the lower courts held petitioner's Patent No. 3,375,643 for a forage crop mower-conditioner (the McCarty or "Haybine" patent) invalid on the theory that no machine which combines mechanical elements of known prior art is patentable unless "new and surprising" physical results are obtained by the combined elements. Practitioners of the art had tried without avail for more than thirty years to develop a mower-conditioner that would work prior to the invention described by the "Haybine" patent. Nonetheless, the lower courts, ignoring the question whether the combination itself was obvious or nonobvious, voided the patent on the grounds that the physical workings of the combined elements were not "new and surprising" and that the elements themselves "merely produce[d] a result consistent with the expected operation of the sum of the constituent elements." The question presented is: Did not Section 103 of the Patent Act of 1952 as interpreted by this Court in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966), repudiate the "new and surprising results" test established by *A&P* in favor of the test of obviousness-nonobviousness, and does not the "Haybine" patent meet this test?

INTRODUCTORY STATEMENT

While the issues in this case involve all types of mechanical inventions, the specific invention at bar—the "Haybine" —relates to a new machine in the critical field of food production. As such, it raises both specific and general issues worthy of this Court's review.

Forage crops—alfalfa, brome grass, sorghum and the like—are economically the United States' second most important agricultural product after corn. When mowed and dried, these forage crops are known as hay. Hay is used for livestock feed; it is of particular use during times, such as winter, when the livestock cannot graze; it is an important source of vitamins, protein and roughage for livestock. (Tr. 7-8)[3]

The drying process is critical to the making of hay because if the crop when baled or gathered has excess moisture after cutting, the hay may mold or catch fire from spontaneous combustion. Moreover, the drying process must be uniform since uneven drying may result in crop loss as the thinner, leafy parts of the crop become overly dehydrated while the thicker stems are drying, and drop off when the harvesting operation takes place. The most important part of the crop is the leaves. (Tr. 23-35)

In the early 1930's it was discovered that conditioning—that is, crushing or cracking the crop stem—would facilitate rapid and uniform drying and reduce crop loss. Since

[3] The appeal to the Ninth Circuit was heard on the original record. "Tr." refers to the transcript of proceedings in the District Court. "Px" and "Dx" refer, respectively, to exhibits introduced in the District Court by Deere and New Holland.

most of the moisture is contained in the crop stems, conditioning reduces the drying time and promotes a uniform drying. Speeding up the drying process is important because it minimizes the time when the cut but unbaled hay is exposed to the threat of rain. If an ungathered crop is rained on, the rain "leaches" out protein and food nutrients and greatly reduces the value of the hay.

Since the thirties, experts in the field have attempted to invent a unitary machine which would both mow and condition forage crops. These attempts at invention were uniformly unsuccessful. The principal "prior art" machine was produced in a half-dozen copies by one Crose in the late 1950's. This machine failed and never entered quantity production because the massive amounts of crop material mowed—up to 10,000 pounds per minute in field conditions —and the variations of different types of forage crops caused the conditioning apparatus to jam or "plug" with crop material. (Tr. 30-32)

Then, in the early 1960's, Horace G. McCarty and Emmett F. Glass invented a successful mower-conditioner, to be called the "Haybine", and assigned the rights to New Holland. (Tr. 318-21) As the Ninth Circuit recognized, New Holland's "Haybine" solved the plugging problem and was the first workable and marketable hay mower-conditioner. (App. 2a) Respondent Deere purchased a New Holland "Haybine" and rapidly copied it detail by detail. Deere then placed this copy on the market as its own Model 480 mower-conditioner. (App. 18a; pp. 10-12, *infra*)

Respondent Deere has now convinced the Ninth Circuit to allow its appropriation of the "Haybine" invention on the ground that a combination of mechanical parts individually

known in the art is not patentable unless the physical results of the combination—viewed microscopically at the level of the working of the parts—are "new and surprising." The test applied by the Ninth Circuit squarely conflicts with the test required by Section 103 of the Patent Act; with this Court's decision in *Graham* v. *John Deere Co., supra;* and with the tests applied by the Second, Fifth, Tenth, and District of Columbia Circuits.

It is apparent from the application of the Ninth Circuit's test in practice—this case is the classic example—that the "new and surprising result" demanded by that Circuit does not refer to whether the patented invention accomplishes a result beyond the grasp of journeyman practitioners of the technology in question. Rather the Ninth Circuit requires that the physical elements themselves interact in a "new and surprising" way. If this test stands it will preclude the patenting of virtually every new mechanical device, for in a mechanical patent the elements can never act in "new and surprising" ways: a roller operates as a roller always does; the function of a gear is foreordained; a cam is but a cam.

All new machines—particularly those designed for use under rough and ready conditions, such as farm machinery —are constructed from mechanical elements individually old; they do not involve such esoterica as lasers. It is in the combination of elements and the overall achievements of that combination where a machine invention lies, not in the operation of individual elements. Thus, the Ninth Circuit's practice of reducing a machine invention to its basic nuts and bolts and refusing to consider the combination of elements as a whole ignores the mechanical inventor's art and smothers all invention as to new machines.

The present case amply demonstrates why the Ninth Circuit has been referred to as "a circuit of patent law despair,"[4] for there is vastly more than a verbal difference between circuits in the articulation of a legal standard. As shown below, the Ninth Circuit has consistently held patents invalid two to five times more frequently than most other circuits and roughly four times more frequently than the average of *all* circuits. The result has been that forum shopping has become a way of life in patent litigation as infringers seek a court hostile to inventors' rights.

The present state of affairs has come about because since 1952 this Court has spoken to the standards of validity under Section 103 only twice. We shall show in this Petition that this case furnishes an ideal opportunity for the Court, by granting certiorari, to reassert its supervisory authority and to reestablish the test for patentability under Section 103 set out in *Graham* v. *John Deere Co., supra.* This would resolve the conflicts between the circuits and rectify the continuing discrepancies in results.

STATUTE INVOLVED

This case involves Section 103 of the Patent Act of 1952, 35 U.S.C. § 103, which provides as follows:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

[4] *1969-70 Annual Review, supra,* at A.1[1]-11 (1970).

subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT OF THE CASE

1. *The Prior Art and the Invention of the "Haybine."* The sole prior machine even roughly similar to the "Haybine" was the Crose machine, which the Ninth Circuit held constituted the significant prior art. The conditioning element in Crose's machine was based upon the principle of a wringer-washer machine. Thus, in the Crose device the load—the mowed crop—was physically forced or "stuffed" between slowly driven smooth rollers which were supposed to condition the crop. (Tr. 104; Px 16A) The overwhelming difficulty faced by those seeking to construct a practical mower-conditioner was the vast volume of crop material generated by the mower in field conditions. The ability of the mower element of the machine to cut the grass-like crops used for forage far outstripped the ability of the conditioning rollers to wring the moisture out of the crop fed into it. Consequently, when the Crose machine was operated, the accumulated crop waiting to be "stuffed" into the slowly-moving rollers caused plugging and breakdowns, rendering the machine impractical. (Tr. 110-13; Px 16B)

New Holland's "Haybine" machine solved the "plugging" problem. (App. 2a) The problem was not solved by a journeyman's tinkering to improve the working of the old wringer-washer approach. Instead, a radically different approach was conceived by McCarty. It was perceived that the path to success lay in developing a conditioner with crushing rolls that moved *faster* than the reel which delivered the crop to the conditioner. Thus, after the "Haybine" cuts the crop, the tines of its raking reel deliver the crop up an inclined guide plate and deposit it directly into the bite between an upper roller with a heavily indented, tread-like surface—called an "aggressive" surface—and a smooth lower roller set slightly behind the upper one. These rollers are driven so as to rotate faster than the rate the material is delivered by the tines, thereby accelerating the flow of crop material and thinning out the thick mat of cut crop moving between the rollers. (Tr. 876-81)[5]

The secret of the success of the "Haybine" lies in the aggressive upper roller and the greater speed of the rollers than of the reel. This combination means that the crop is drawn through the conditioning rolls at a significantly faster speed than the crop is harvested and deposited in front of the rollers. The consequent thinning of the crop prevents clogging and allows the "Haybine" to operate without problems with all types of forage crops. (Tr. 483-84; 520-21)

2. *The Success of the "Haybine."* When New Holland's "Haybine" was invented in the early 1960's, no hay mower-conditioners were available in the United States and none were being sold commercially. As to the prior art Crose machine, there were a grand total of six made in 1956 and

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[5] This thinning out is technically referred to as "attenuation." The Ninth Circuit opinion erroneously states that attenuation was not specified in New Holland's patent claims. (App. 4a) In fact, the patent claims described the operation of the reel tines and rollers in detail. (Px 2A) This description sets out a mechanism which inherently attenuates, and the uncontradicted testimony was that any person skilled in the art would understand that the mechanism described thins or attenuates the crop flowing through it. (Tr. 483-84, 878, 892) This is sufficient to preserve the attenuation claim. *United States* v. *Adams*, 383 U.S. 39, 48-49 (1966); *Shaw* v. *E.B. & A.C. Whiting Co.*, 417 F.2d 1097, 1106 n.11 (2d Cir. 1969), *cert. denied*, 397 U.S. 1076 (1970).

one in 1958. The Crose machines were of the "wringer-washer" roller variety; by the time of the introduction of the "Haybine," all of the Crose machines had been junked. (Tr. 209-13; 221-22) They had been subject to major plugging problems. (App. 2a)

The "Haybine" was introduced commercially in 1964. In its first year, 3,000 "Haybine" mower-conditioners were sold. By 1967, nearly 12,000 mower-conditioners, manufactured by a number of different companies, were being sold annually. In the space of the few years since its invention, the hay mower-conditioner has now achieved a prominence in the farming industry unequalled by any other new piece of farm equipment introduced in the past fifty years.[6] Over 25,000 machines are now sold annually.[7] In fact, the invention of the "Haybine" created an entirely new type of farm machinery which now accounts for approximately $100,000,000 in annual sales by manufacturers in North America alone.

3. *Deere's Copying of the "Haybine."* Respondent Deere is the largest maker of farm equipment in the United States and the world. Deere holds itself out as producing virtually all the types of machinery a farmer may need and has a wide network of dealers which it prefers to handle only Deere equipment. New Holland is a smaller company which makes only specialized kinds of farm machines. With the initial success of the "Haybine," Deere was confronted by the fact that a number of its dealers began selling the New Holland "Haybine." Deere concluded that, in order to pre-

[6] See Implement and Tractor, Vol. 83, No. 12, pp. 30-33, May 21, 1968.

[7] Bulletin No. 22110, Farm and Industrial Equipment Institute, Feb. 7, 1975.

vent penetration of its dealer network by New Holland machinery, it was urgent that Deere produce an equivalent machine. (Dx 11)

In October, 1965, there was a "Product Planning Review" at the John Deere plant at Ottumwa, Iowa. At the Review, Deere's engineers displayed a number of machines to show "what we had accomplished *and what we intended to produce.*" (Dx 81, p. 83; emphasis supplied.) Set out for viewing were a number of Deere machines, presumably painted in their traditional green and yellow Deere colors. Also displayed—and undoubtedly a center of attraction in its bright New Holland red and yellow paint—was an actual New Holland "Haybine." (Tr. 817-18; Dx 27) It was fitting that Deere personnel chose to display a New Holland "Haybine" as an example of "what [they] intended to produce"; they had already determined to copy the "Haybine."

In July, 1965, Deere had purchased a "Haybine" and a month later, after appropriate measurements, a work order was issued containing specifications virtually identical to those of the "Haybine." (Dx 17, p. 83, and Tr. 813-14) The Deere mower-conditioner, known as the Model 480, cut a swath 8′9″ wide—exactly like the "Haybine." This is not a standard width and no Deere machine had ever cut that width before. This cutting width was admittedly chosen because of the width of the "Haybine." (Tr. 837) The mower frequency of the Deere Model 480 was 1400 cycles—also exactly that of the "Haybine." This frequency is not standard and no Deere machine had ever used this particular frequency before. (Tr. 814)

In fact, the initial Deere Model 480 was an essentially exact copy of the "Haybine" with one disastrous exception: Deere's engineers placed the aggressive conditioning roller on the bottom rather than on the top. But the secret of the

success of the "Haybine" was not in the width of its cut or the cycle frequency of the mower; the key was in the area that the Deere engineers miscopied. As a result, the Deere Model 480 would not operate correctly; it plugged where the "Haybine" did not. Deere's engineers tried a variety of changes in order to cure the problem, but were unsuccessful until months later, after side-by-side comparisons, they finally realized they had miscopied the "Haybine" in this respect. Deere's engineers then put the aggressive roller on the top in their new production and went into the field and corrected the machines already shipped. (Dx 80, pp. 125-26; Tr. 811)

Of course, Deere's engineers and technicians well knew that they were copying the "Haybine." And in 1966, Deere's chief engineer in charge of developing the Model 480 wrote to the manager and the top executive of Deere's Ottumwa plant, where the copying was taking place:

> This is only to inform you that we are quite concerned with the possibility that our [Model 480] design will infringe several patents which New Holland may have on file.
>
> If they are as smart as we think they are, they will cover their Haybine from end to end. If they do, we are in for a surprise. Our only hope is that when we find out what they have, Parker [Deere's patent lawyer] can find enough prior art to help. We still think it will require a license, but nothing can be done until any pending applications are issued. (Dx 30, Tr. 828-30)

Deere's chief engineer expressed these unqualified views—including his hope that somebody else would find some "prior art to help"—notwithstanding the fact that he personally had inspected, back in the late 1950's, two of the handful of Crose machines produced. (Dx 81, pp. 110, 141-43)

4. *"A Circuit of Patent Law Despair."* Deere has its home office in Moline, Illinois. New Holland has its main office in Pennsylvania. Nevertheless, on June 3, 1969, Deere filed this suit against New Holland for a declaratory judgment in the United States District Court for the Eastern District of California. It must be observed that Deere was not forcing into court a patent owner unwilling to enforce its patent; New Holland commenced litigation the same day in a District Court in Illinois, where Deere is headquartered. The following statistics demonstrate why Deere chose to file suit in the Ninth Circuit:

PATENTS UPHELD BY CIRCUIT, 1966-70[8]

Circuit	Total Patent Cases	Number Found Valid	Percentage Found Valid
9	46	4	8.7%
1	10	3	30.0%
2	25	8	32.0%
3	16	5	31.3%
4	24	5	20.8%
5	32	16	50.0%
6	22	8	36.4%
7	73	32	43.8%
8	17	0	0.0%
10	9	4	44.4%
D.C.	2	0	0.0%
Ct. Cl.	58	40	69.0%
Total	334	125	37.4%

As the table indicates, in the five-year period 1966-70 when the suit at bar was filed, the Ninth Circuit upheld the

[8] The statistics set forth in this table are those which were current about the time this lawsuit was filed in 1969. They are taken from M. Horn and S. Epstein, *The Federal Courts' View of Patents—A Different View*, 55 J. Pat. Off. Soc'y 134, 146 (1973).

validity of less than 9% of the patents it considered.[9] The proportion of patents upheld by the Ninth Circuit is thus less than one-quarter the average for all circuits. Indeed, among the circuits which had any significant number of patent decisions, only the Eighth Circuit has a record comparable to that of the Ninth Circuit.[10] The reason for the great variation in the percentage of patents held invalid in the Ninth Circuit from that in most other circuits is not difficult to determine: The test applied by the Ninth Circuit to determine the validity of combination patents under Section 103 conflicts with the test set out by *Graham* v. *John Deere Co., supra,* and applied by most other circuits.

Thus, in the Second Circuit, the test for combination patents under Section 103 is whether "the bringing together of these elements would have been obvious." *Shaw* v. *E.B. & A.C. Whiting Co.,* 417 F.2d 1097, 1104-05 (2d Cir. 1969), *cert. denied,* 397 U.S. 1076 (1970). As is developed further below (pp. 22-23), this formulation has been endorsed by this Court in *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation,* 402 U.S. 313, 314-15 (1971).

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[9] The statistics on percentage of patents found invalid by the various circuits vary somewhat from time to time, but the Ninth Circuit consistently invalidates a much greater proportion of the patents it reviews than do most other circuits. See Comment, *Blonder-Tongue Bites Back: Collateral Estoppel in Patent Litigation—A New Look,* 18 Vill. L. Rev. 207, 227 (1972) (hereinafter *Blonder-Tongue Bites Back*); L. Baum, *The Federal Courts and Patent Validity: An Analysis of the Record,* 56 J. Pat. Off. Soc'y 758, 762 (1974).

[10] Unlike the Ninth Circuit, the Eighth Circuit appears to have moved away from its hostility toward the rights of inventors in recent years and has recently upheld the validity of several patents. *Blonder-Tongue Bites Back, supra,* at 227. As the table indicates, there is substantially less patent litigation in the Eighth Circuit than in the Ninth.

While employing somewhat different words from the Second Circuit's, other circuits[11] apply tests which are functionally close to the Second Circuit's and different in practice from that of the Ninth Circuit.

In the Ninth Circuit, the test is whether the combination provides a "new and *surprising* result." (App. 4a; emphasis supplied) See also *Regimbal* v. *Scymansky,* 444 F.2d 333 (9th Cir. 1971).[12] This "new and surprising result" test does not refer to the sort of "new and surprising" result obtained in this case—the fact that the "Haybine" machine worked, whereas the prior art did not—but seeks "new and surprising" results at the micro-element level, namely, whether the individual physical elements performed any function other than what they characteristically perform. (App. 3a) Moreover, in applying its "new and surprising result" test, the Ninth Circuit has explicitly rejected the

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[11] The Tenth Circuit phrases the matter as whether the combination "accomplishes either a new result or an old result in a more facile, economical and efficient way. . . ." *A. E. Staley Mfg. Co.* v. *Harvest Brand, Inc.,* 452 F.2d 735, 738, *cert. denied,* 406 U.S. 974 (1972). And in the District of Columbia Circuit, the test is whether the combination gives "a new result, an unexpected result, a far more efficient result, or a more economical result. . . ." *Corning Glass Works* v. *Brenner,* 470 F.2d 410, 420 (1972). It is clear that the results referred to in the Tenth and District of Columbia Circuits are the overall achievements of the patented machines, not the micro-results worked by the individual mechanical elements functioning in the patented machine; the references to "economical" and "efficient" results are only meaningful in the context of the overall achievements of the patented machine.

[12] Other representative Ninth Circuit cases applying the "new and surprising result" test include *Mayview Corp.* v. *Rodstein,* 480 F.2d 714, 718 (9th Cir. 1973); *Hewlett-Packard Co.* v. *Tel-Design, Inc.,* 460 F.2d 625, 629 (9th Cir. 1972); *Santa Anita Mfg. Corp.* v. *Lugash,* 369 F.2d 964, 966-67 (9th Cir. 1966), *cert. denied,* 389 U.S. 827 (1967); and *Bentley* v. *Sunset Distributing Corp.,* 359 F.2d 140, 144 (9th Cir. 1966). All the cases cited except *Mayview Corp.* specifically rely upon the *A&P* case.

use of the evidentiary tests under Section 103 established by *Graham* v. *John Deere Co., supra,* and *United States* v. *Adams, supra.* (App. 5a)

5. *The Decisions Below.* As noted, Deere filed the present suit against New Holland for a declaratory judgment that the "Haybine" patent is invalid. New Holland counterclaimed for infringement, and Deere admitted that the patent, if valid, had been infringed.[13]

After trial, the District Court held the "Haybine" patent invalid. It observed that:

> The Crose machine affords a raking reel, cutter bar, guide ramp, conditioning rolls and the other key elements of the ["Haybine"] . . . device mounted in the frame in substantially the same operational relationship. . . . The only distinctions relied upon by defendant [New Holland] are those already recited and admittedly are old. Where an invention is comprised of old elements, the combination must result in new and surprising consequences and not merely produce a result consistent with the expected operation of the sum of the constituent elements. (App. 13a)

The District Court cited, as the Ninth Circuit customarily does in applying the test just quoted, this Court's pre-Section 103 decision, *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.,* 340 U.S. 147 (1950).[14] The District

[13] The action in the District Court involved three other minor patents, in addition to the basic McCarty "Haybine" patent, No. 3,375,643. The District Court held the three minor patents invalid as well as McCarty's. In the Court of Appeals, to sharpen the issues, New Holland contested the judgment of invalidity only as to the basic "Haybine" patent.

[14] The passage from the *A&P* case which enunciates the so-called "new and surprising result" test appears in 340 U.S., at

(footnote continued on following page)

Court made it plain that the "new and surprising result" being searched for was not to be looked for in the overall result of the machine but in the workings of the elements; the point that the "Haybine" did not plug, whereas the Crose machine did, was not pertinent. Such an improvement "is not a new and surprising result," held the District Court. (App. 14a) "It is an improvement accomplished by the *obvious method* of selecting proven elements from known prior art devices." (App. 14a; emphasis supplied)—While that "method" may be obvious, how one goes about selecting the right elements in a particular case is, of course, often far from obvious.

The District Court did not bother to consider whether making the particular combination of elements which made up the "Haybine" was "obvious."[15] The facts that the "Haybine"—hardly surprisingly—merely produced "a result consistent with the expected operation of the sum of the constituent elements," and employed the "method of

(footnote continued from preceding page)

151-52. The Court there expressly recognized that the test it enunciated discriminated against mechanical patents as opposed to chemical or electrical patents, and made a valid mechanical patent a rarity: "Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics." *Id.,* at 152. While counsel attacking the patent in *Calmar* urged this language on the Court and urged the Court to reaffirm the *A&P* standard with its particular strictures on mechanical combination patents (Br. for Petitioner, No. 37, O.T. 1965, pp. 22-27), the Court's opinion in *Graham-Calmar* studiously avoids doing so.

[15] Similarly, Deere's trial counsel was not anxious to try to prove that the making of the particular combination of elements involved in the McCarty invention was "obvious"; he said in his opening statement: "In the first place, we are really not dealing with obviousness here, Your Honor; it doesn't enter into the case . . . ." (Tr. 18)

selecting proven elements from known prior art devices" (though not, of course, from successful hay mower-conditioners, for there were none) were enough to condemn the patent.

Moreover, the District Court held that it was irrelevant that the New Holland "Haybine" solved a long-felt and unfulfilled industry need; that the "Haybine" met immediate acceptance from the industry; that, where Crose had sold a half dozen machines, New Holland had sold tens of thousands; that Deere had to copy the "Haybine" to produce its own mower-conditioner; that when Deere's engineers first copied the "Haybine" they copied it wrong; or that the mechanical success of the "Haybine" was due to the use of an aggressive, high-speed upper roller relating to a cam reel—never before used in a mower-conditioner—which overcame the disadvantages of the prior art. (App. 18a)

On appeal, the Ninth Circuit recited the fact that the prior art machines—Crose's machines—"consisted of a cutting blade in combination with a raking reel whose tines lifted the crop across the cutting blade and then pushed the cut crop material up a short ramp to the conditioning rolls, which would crush or crack the stems of the cut crop, allowing moisture to escape." (App. 2a) The court found, correctly enough, that the prior art "machines were subject to frequent plugging when cut hay would pile up in front of the conditioning rolls and, consequently, were not widely used." (App. 2a)

The Court of Appeals also—most significantly—found that McCarty's device "solved the plugging problem." (App. 2a) This was done, the court found, by:

> (1) placing the raking reel closer to the rolls and using cam-actuated tines on the reel to deliver the cut hay directly to the rolls; (2) installing a rough-surfaced upper roll slightly ahead of the lower roll to "strip" the reel of the cut crop; and (3) increasing the speed of the rolls relative to the reel to aid in stripping the reel. (App. 2a)

But this was all irrelevant as far as the Ninth Circuit was concerned, since the court then made the finding—crucial under the test of patentability applied by it—that the "Haybine" "employed the same or similar elements existing in prior art [presumably, a cutting blade, a raking reel and some sort of rollers] but in . . . altered form." (App. 2a) The court struck down the "Haybine" patent on the theory that a patent, such as this, comprised of "old elements"—cutting blades, a reel and rollers—"must result in new and surprising consequences and not merely produce a result consistent with the expected operation of the sum of the constituent elements." (App. 3a)

To the Ninth Circuit, it mattered not whether "the *bringing together* of these . . . elements would have been obvious." See *Shaw* v. *E.B. & A.C. Whiting Co., supra,* 417 F.2d, at 1105 (emphasis original). Accordingly, the court did not trouble to make any finding as to whether it was obvious or nonobvious to utilize a fast-moving pair of rollers with an aggressive upper roller set close to the raking reel to overcome the problems which had caused the Crose "prior art" machine to fail under field conditions. Nor did the court offer any enlightenment as to how it could ever be that a machine composed of old elements, once constructed, could do anything other than "produce a result consistent with the expected operation of the sum of the constituent elements."

REASONS FOR GRANTING THE WRIT

1. In October Term, 1965, this Court decided *Graham* v. *John Deere Co.,* 383 U.S. 1 (1966), and *United States* v. *Adams,* 383 U.S. 39 (1966). In those two opinions, this Court held that Section 103 of the Patent Act of 1952 was meant by Congress to focus on "nonobviousness" as a test of patentability: "Congress has emphasized 'nonobviousness' as the operative test . . . ." 383 U.S., at 14. This Court quoted with approval the passage from the House and Senate Reports on the Patent Act of 1952 which expressed the hope—and the admonition—that Section 103 "should have a stabilizing effect and minimize great departures which have appeared in some cases." 383 U.S., at 15, quoting H. Rep. No. 1923, 82d Cong., 2d Sess. 7 (1952); S. Rep. No. 1979, 82d Cong., 2d Sess. 6 (1952). While this Court cited the *A&P* case to put that decision in historical perspective, see 383 U.S., at 3, 6, 12, 17, the Court was studious not to endorse the "new and surprising consequences" formulation or any of the other formulations as to the test of patentability set forth in the *A&P* decision. Indeed, the Court indicated that use of the language employed in the *A&P* case had resulted in confusion and variations of results as between cases. See 383 U.S., at 12, 14.

In October Term, 1969, this Court decided *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.,* 396 U.S. 57 (1969), and reaffirmed that the appropriate test under Section 103 is "the obvious-nonobvious standard." 396 U.S., at 63. The patented machine in *Black Rock,* one for laying bituminous concrete or "black top," consisted of putting on a single chassis two machines which were well known

in the prior art: (1) a radiant heat burner and (2) a spreader, tamper and screed for spreading and shaping the black top.

This Court observed that the issue of patentability "must turn on whether the combination supplied the key requirement." *Id.,* at 60. Applying *Graham,* it struck the patent down by concluding that "the combination was reasonably obvious to one with ordinary skill in the art." *Id.,* at 60. While the putting of the elements together on the same chassis was "perhaps a matter of great convenience," the combination did not pass muster under the "obvious-nonobvious standard," which the Court expressly reaffirmed. *Id.,* at 60, 62-63. —In *Black Rock,* there was, of course, no difficulty in combining the various machines on a single chassis. Here, the problem that defied invention, until McCarty solved it, was the practical development of a machine which could function both as a mower and as a conditioner. The two functions had seemed operationally incompatible. Because of the great quantities of crop material generated by the mowing element, which, as developed above (pp. 5, 8), prevented the conditioning element from functioning, it seemed impossible to develop a practical unitary combination of the mower and the conditioner which would work under field conditions.

In this Court's opinion in *Black Rock,* a passing citation to the *A&P* case was made, even though there was no citation or quotation of the "new and surprising consequences" language from the *A&P* opinion. *Id.,* at 61. But, unrestrained by subsequent review by this Court, the result of this reference has been confusion among the lower courts and commentators as to the correct standard of patent-

ability under Section 103.[16] Thus, the Ninth Circuit in the present case used *A&P's* "new and surprising result" test in the belief that "that requirement has not been superseded but is now codified in 35 U.S.C. § 103." (App. 4a) On the other hand, the Fifth Circuit, for example, has explicitly rejected this view in *National Athletic Supply Corp.* v. *Tone-O-Matic Products, Inc.*, 421 F.2d 407, 409-10 (5th Cir. 1970), and *Stamicarbon, N.V.*, v. *Escambia Chemical Corp.*, 430 F.2d 920, 923-24 (5th Cir.), *cert. denied*, 400 U.S. 944 (1970).

Indeed, this Court has apparently endorsed as the proper test for the validity of a combination patent the simple application of the "obviousness-nonobviousness" test to the

[16] *E.g.*:

> Many serious and well-qualified observers had assumed that the introduction of Section 103 of the patent statute in 1952 had sounded the death knell of the *A&P* case. Indeed, Section 103, in its final form, was drafted as an antidote for, and was directly responsive to, *A & P*. Confirmation that the antidote was wiping out the dread disease developed slowly in the United States from 1953 until 1966 but seemed clearly established with Justice Clark's disposition of the patent *Trilogy*, i.e., *United States* v. *Adams*, *Graham* v. *John Deere*, and *Calmar* v. *Cook*. In *Anderson's-Black Rock*, however, Justice Douglas asserts the proposition that the doctrines of both *A & P* and the *Trilogy* are to be viewed as alive, vital, and jointly operative as if they are cooperative legal entities rather than the essentially inconsistent propositions of law which they are. *1969-70 Annual Review*, at A.1[1]-1; footnotes omitted.

See also Note, *After Black-Rock: New Tests of Patentability—The Old Tests of Invention*, 39 Geo. Wash. L. Rev. 123 (1970); Note, *Patentability in the Sixth Circuit*, 2 Memphis State L. Rev. 400 (1972).

We do not mean to express our approval of the view set forth by the quoted commentator, since, from the discussion made above (pp. 21-22), it seems to us that *Black Rock* is completely consistent with the *Graham-Calmar-Adams* trilogy, if properly understood. But the point of the matter is that a number of commentators, and, more significantly, many of the lower courts, have not properly reconciled the cases.

making of the combination, as enunciated by the Court of Appeals for the Second Circuit in *Shaw* v. *E.B. & A.C. Whiting Co., supra.* See *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation*, 402 U.S. 313, 314-15 (1971), where the "inquiry mandated by *Graham* v. *John Deere Co.*" was described by this Court as fulfilled by a lower court which applied, as to a combination patent, the test of whether "it would have been obvious to one ordinarily skilled in the art . . . to combine these three old elements . . . ."

2. The conflict between the various circuits on this issue stems directly from the miscomprehension by a number of circuits, most particularly the Ninth, as to the proper test of patentability under Section 103 after *Graham* and *Black Rock*. This miscomprehension, in turn, derives from failure of this Court to exercise its supervisory functions to assure that proper standards of patentability are applied. An average of about sixty cases per year involving the issue of patentability are decided in the Courts of Appeals,[17] and numerous petitions for certiorari are annually presented to this Court. Yet, in the twenty-three years since the passage of the Patent Act of 1952, this Court has considered the standard of patent validity under Section 103 on precisely two occasions, most recently six years ago.[18]

[17] See L. Baum, *The Federal Courts and Patent Validity: An Analysis of the Record*, 56 J. Pat. Off. Soc'y 758, 760 (1974).

[18] *Blonder-Tongue* contains no holding as to the standard of patentability, since the case was decided on the basis of collateral estoppel, involving a partial overruling of the former doctrine that a patentee was not estopped by an adjudication of invalidity that a patentee was not estopped by an adjudication of invalidity in a prior suit if a second action involved an unrelated alleged infringer, set down in *Triplett* v. *Lowell*, 297 U.S. 638 (1936).

The Constitution, in providing for the establishment of the patent system, recognized that the grant of patents in appropriate cases is beneficial to society through the promotion of inventions and discoveries which further human knowledge. *Graham* v. *John Deere Co., supra,* 383 U.S., at 9. We submit that this Court should not allow the patent system, through the continued failure of supervision, to be subjected to the strains inherent when vastly different standards of patentability are applied by different circuits; when the validity of a patent turns upon a race to the courthouse door by forum-shopping infringers; and when some courts, including the Ninth Circuit, are applying a test for combination patents that no invention of machinery can meet and that is alien to the governing statute.

This case offers an ideal opportunity for this Court to participate once again in the course of adjudication in this area and by its participation to "correct instances of improper administration" of the governing standard by a pattern of repeated misapplication. *Cf. Rogers* v. *Missouri Pac. R. Co.,* 352 U.S. 500, 509-10 (1957). As this Court has recognized, the certiorari jurisdiction exists not only to enunciate the governing legal standards, but to insure their application in practice where there is substantial and clear evidence of their misapplication. Standards are meaningless if not applied.

3. Here the departure from the established standards is not an isolated event but a pattern of adjudication in a particular circuit. The Ninth Circuit has engrafted upon the test of "obviousness-nonobviousness" taught by this Court in the *Graham* decision—and, we submit, reaffirmed in the *Black Rock* and *Blonder-Tongue* decisions—a test

which is impossible for any mechanical patent involving a combination of elements—as virtually every mechanical patent does—to satisfy.[19]

The Ninth Circuit's test focuses on whether the particular mechanical elements, viewed at the microscopic physical level, achieve any "new and surprising" result from the result they characteristically perform. Absent some form of supernatural intervention, it is hard to see how they could. All the physical elements of McCarty's patent—an aggressive roller, high-speed driving of rollers, the positioning of one roller with another—were individually known to the mechanical arts. Of course, no one had had the foresight and brilliance to combine these elements in the particular fashion McCarty chose so as to make possible a workable mower-conditioner for hay. It is true, obviously, that in the "Haybine" the aggressive roller, the high-speed drive, and the positioning of the rollers individually produce the exact physical results that these elements are ordained by the laws of physics to perform. There is nothing "new or surprising" about them, viewed at this level.

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[19] The Ninth Circuit managed to pay lip service to the "obviousness" rule by redefining "obviousness" as whether or not a "new and surprising result," rather than a result "consistent with the expected operation of the sum of the constituent elements", was involved. (App. 3a) And so "obviousness" has become the *thing to be defined*—like "patentability" or "invention"—rather than, as this Court taught in the *Graham* case, the *definition* of "patentability." Thus, the Ninth Circuit concluded that: "The district court did not err when it determined the issue of obviousness by requiring a new and surprising result." (App. 4a) By the end of the opinion, the word "obviousness" is used as an exact synonym for "patentability"; the Court of Appeals concludes: "Since the proper test of obviousness was used [as just shown, all that is meant is that "obviousness" or "patentability" does not exist unless the workings of the elements are "new and surprising"], we must affirm the district court's conclusion . . . ." (App. 5a)

But the fact of the matter is that no one had ever combined them in this fashion before in connection with a hay mower-conditioner, and that the combination was completely non-obvious.[20] *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co., supra,* 396 U.S., at 60; see *Shaw* v. *E.B. & A.C. Whiting Co., supra,* 417 F.2d, at 1104-05.

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[20] In the *Graham-Calmar-Adams* trilogy, this Court recognized and referred to various "evidentiary" or "secondary" tests of "obviousness" to assist the lower courts. Because of the Ninth Circuit's chimerical pursuit of the "new and surprising result" test, the courts below ignored and explicitly refused to apply any of these evidentiary tests of nonobviousness. (App. 5a, 18a) The "Haybine" meets all of these evidentiary tests:

(a) The "Haybine" satisfied the long-felt need for a mower-conditioner which had been unfulfilled for over 30 years. See *Graham* v. *John Deere Co., supra,* 383 U.S., at 17-18; *General Tire & Rubber Co.* v. *Firestone Tire & Rubber Co.,* 489 F.2d 1105, 1119 (6th Cir. 1973), *cert. denied,* 417 U.S. 932 (1974);

(b) The "Haybine" succeeded where all other prior attempts to produce a workable, practicable mower-conditioner had failed. See *Graham* v. *John Deere Co., supra,* 383 U.S. at 17-18; *Twentier's Research, Inc.* v. *Hollister, Inc.,* 319 F.2d 898, 902 (9th Cir. 1963);

(c) The "Haybine" was immediately accepted by farmers and by practitioners of the relevant art and, indeed, led to the creation of a whole new and distinct type of farm machinery. See *United States* v. *Adams, supra,* 383 U.S., at 52; *General Tire & Rubber Co.* v. *Firestone Tire & Rubber Co., supra,* 489 F.2d, at 1119;

(d) The utilization of an aggressive, higher-speed conditioning upper roller by the "Haybine" overcame the disadvantages of the prior art which discouraged the search for new inventions in this area. See *United States* v. *Adams, supra,* 383 U.S., at 52;

(e) The combination of elements was so far from obvious that Deere's engineers had to copy the "Haybine" detail for detail—including even the irrelevant ones—and even then were unable to make their Model 480 operate properly because they had the rolls backwards, until they placed the aggressive roller on the top rather than on the bottom. See *Shaw* v. *E.B. & A.C. Whiting Co., supra,* 417 F.2d, at 1106; *Ling-Temco-Vought, Inc.* v. *Kollsman Instrument Corp.,* 372 F.2d 263, 269 (2d Cir. 1967).

The departure of the Ninth Circuit from the correct standard of "obviousness" taught by the *Graham-Calmar-Adams* trilogy is plain. This case is an ideal vehicle—based upon the clear and correct factual findings of the Ninth Circuit and the clear application of its erroneous legal principle to those findings—for this Court to intervene to insure the correct application of its standards.

4. This Court's decision in *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation,* 402 U.S. 313 (1971), which permits the assertion of a plea of collateral estoppel by a second alleged infringer against a patentee whose patent has been declared invalid in an earlier litigation, is a further reason warranting this Court's intervention in this case. That decision destroys the possibility for a conflict of circuits as to the validity of this patent—a conflict which in the past has led this Court to grant certiorari, as it did in the case of the patent involved in the *Graham* case itself.

The principle announced in the *Blonder-Tongue* decision was one designed to ease the burden of patent litigation on the lower federal courts. See 402 U.S., at 335-41, 348-49. But for the achievement of this laudable goal to be consistent with the uniform administration of the standard of patentability, it must, we submit, be attended by a somewhat higher level of participation by this Court in the course of patent validity adjudication. This is not only because of the more drastic consequences of a declaration of patent invalidity, but by reason of the fact that the possibility of a conflict of circuits as to a particular patent is now destroyed, at least where the finding of invalidity occurs in the first circuit in which the patent is litigated.

And such a finding will often be the case where the infringer "forum shops" with a declaratory judgment action, as was the case here. *Cf. Schriber Co. v. Cleveland Trust Co.*, 305 U.S. 47, 50 (1938).

Without the possibility of a contrary result as to the validity of the patent in a later forum, the divergences of standards as to patent validity among the circuits can become even more extreme, as is the case with the Ninth Circuit's additional requirements exemplified by the decision below. Unless this Court participates in patent validity adjudication by taking a case such as the present one, the governing standard which it taught in the *Graham-Calmar-Adams* trilogy will become an empty one, and the desire of the Congress that the uniform test of "obviousness" be applied to have "a stabilizing effect and minimize great departures which have appeared in some cases" (see p. 20, *supra*), will be frustrated.

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The improper "surprising result" test applied by the Ninth Circuit to invalidate the "Haybine" patent will strike down every future patent on mechanical inventions because every new mechanical patent of necessity involves a combination of old elements. Moreover, in the case of every mechanical invention, the function of the old elements is known. The invention lies in the combination of those elements to produce a machine which is new, different, more efficient, or better in some other way than preceding machines. After the combination is made, the physical results are not "surprising" in the sense that the individual elements perform functions different than the functions they have previously performed, but that does not demonstrate that the combination of the various elements to make the

machine was obvious. *Corning Glass Works* v. *Brenner*, 470 F.2d 410 (D.C. Cir. 1972); *A.E. Staley Mfg. Co.* v. *Harvest Brand, Inc.*, 452 F.2d 735 (10th Cir.), *cert. denied*, 406 U.S. 974 (1972).

The Ninth Circuit has misapplied Section 103 of the Patent Act of 1952 and miscomprehended this Court's decisions in *Graham* and *Black Rock*. It has engrafted upon the clear and judicially administrable test of "obviousness" taught by this Court in *Graham* a test which is analytically impossible to fulfill. The test of patentability applied by the Ninth Circuit conflicts with that applied by most other circuits, and will invalidate virtually any patent granted in the future upon mechanical inventions.

Surely it is part of this Court's role in this area to insure that standards of patentability be neither overly lax nor impossibly strict. Just as this Court's intervention has been available to strike down a patent—although upheld unanimously in the lower courts—on a trivial improvement to a plastic bottle cap (*Calmar, Inc.* v. *Cook Chemical Co.*, decided with *Graham* v. *John Deere Co., supra*), it should also be available to review a decision such as the one below, holding invalid a basic patent on a brand new important item of farm machinery; a patent granted to one who succeeded where others failed and produced a practical item of machinery, widely used by the nation's farmers and stockmen. In the long run, the protection of genuine inventions, to the extent contemplated by the constitutional scheme as implemented by Section 103 of the Patent Act, is one that will result in entry of new competitive factors

into the marketplace.[21] In as clear a case as this one of the application of an erroneous and impossible standard, this Court's intervention through certiorari is warranted in order to keep the balance true.

[21] The record indicates here that Deere looked at the Crose machines in the 1950's, but was not stimulated by them to develop or invent a successful mower-conditioner. (Tr. 838-40) It remained for McCarty, an inventor salaried by New Holland, a much smaller factor in the industry, to do so. Characteristically, dramatic product inventions are made by smaller concerns or independent parties:

> It cannot be only chance that the Western Union interests underestimated the telephone, that the Telephone Company was slow to appreciate the possibilities of radio, that it remained for newcomers to bring out the inexpensive table model radio receiver . . . and that one small concern made the first F.M. transmitters while a local network was the first commercial enterprise to install them. Kottke, *Electrical Technology and the Public Interest*, p. 127 (1944).
>
> The British and American chemical firms took no part in the crucial discoveries connected with penicillin, and it was difficult enough to persuade them to take part at the pilot plant stage even when the chemo-therapeutic virtues of penicillin had been placed beyond doubt. . . . The Kroll system of producing ductile titanium was strangely neglected by the metallurgical and chemical corporations. When Baird called on the Marconi Company in 1925, he was told that they had no interest whatever in television. Jewkes, Sawers & Stillerman, *The Sources of Invention*, pp. 189-90 (1958) (footnotes omitted).

CONCLUSION

For the reasons stated above, this Petition for Certiorari should be granted.

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APPENDIX

A. Opinion of the Court of Appeals

UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

No. 71-1897

DEERE & COMPANY,

Plaintiff-Appellee,

vs.

SPERRY RAND CORPORATION,

Defendant-Appellant.

OPINION

[March 31, 1975]

Appeal from the United States District Court
for the Eastern District of California

Before:

TRASK and WALLACE, *Circuit Judges,*
and KELLEHER,* *District Judge.*

PER CURIAM:

Deere & Company (Deere) brought this action to declare invalid four hay-harvesting patents owned by Sperry Rand Corporation (Sperry Rand). The district court held the patents invalid because the patented machine was a com-

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* Honorable Robert J. Kelleher, United States District Judge, Central District of California, sitting by designation.

bination of old elements anticipated by the prior art of mower-conditioners and containing only obvious improvements upon it. Sperry Rand appeals, limiting its arguments to claims 13 (method), 16 (device) and 20 (machine) of Patent No. 3,375,643 (the '643 patent). We affirm.

The '643 patent describes a hay-harvesting machine, the "Haybine," designed to mow hay and condition the cut crop for quick drying in a single operation. Prior mower-conditioners known to the art (exemplified by the Crose machine[1]) consisted of a cutting blade in combination with a raking reel whose tines lifted the crop across the cutting blade and then pushed the cut crop material up a short ramp to the conditioning rolls which would crush or crack the stems of the cut crop, allowing moisture to escape. These prior machines were subject to frequent plugging when cut hay would pile up in front of the conditioning rolls and, consequently, were not widely used. New Holland, a division of Sperry Rand, solved the plugging problem in the Haybine by: (1) placing the raking reel closer to the rolls and using cam-actuated tines on the reel to deliver the cut hay directly to the rolls; (2) installing a rough-surfaced upper roll slightly ahead of the lower roll to "strip" the reel of the cut crop; and (3) increasing the speed of the rolls relative to the reel to aid in stripping the reel. The Haybine employed the same or similar elements existing in prior art but in the above altered form.

At the outset, Sperry Rand asserts that the district court erred in holding that the defendant-owner of a patent in

[1] Seven hay-harvesting machines were custom built and sold from 1956 to 1958 by the H. L. Crose Company of Tulare, California. One was produced at trial. It had been used for several years by one who made his living mowing and conditioning hay for growers. The parties agree that this machine is the prior art most closely resembling the patented device.

a declaratory judgment action has the burden of proof on validity of the patent, contrary to the statutory presumption of validity contained in 35 U.S.C. § 282.[2] However, when a patent is attacked as obvious in light of prior art, the presumption dissipates upon a showing that the prior art was not brought to the attention of the patent examiners. *Hewlett-Packard Co.* v. *Tel-Design, Inc.*, 460 F.2d 625, 628 (9th Cir. 1972). The Crose hay harvester, conceded to be the most important prior art with respect to the '643 patent, was not presented to, nor considered by, the Patent Office in granting the challenged patent. Hence, the presumption was insufficient in the face of the unconsidered prior art to shift the burden of proof on the validity issue to Deere.

Sperry Rand primarily argues that the district court used an improper standard for determining obviousness under 35 U.S.C. § 103.[3] The district court required that a combination patent comprised of old elements "must result in *new and surprising* consequences and not merely produce a result consistent with the expected operation of the sum of the constituent elements." (Emphasis added.) The "unusual or surprising consequences" test for patentability of combination devices originated in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equip. Corp.*, 340 U.S. 147, 152

[2] 35 U.S.C. § 282 states in part: "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

[3] 35 U.S.C. § 103 states in part:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

(1950). That requirement has not been superseded but is now codified in 35 U.S.C. § 103, which denies patentability if the differences between the subject of the patent and the prior art would have been obvious to a person having ordinary skill in the art. *Graham* v. *John Deere Co.*, 383 U.S. 1, 14-17 (1966). While we have more recently emphasized the "unusual or surprising" language in *A & P Tea,* we have also authorized slight modifications of this language, such as "new and unexpected" results. *Regimbal* v. *Scymansky,* 444 F.2d 333, 338-40 (9th Cir. 1971). The district court did not err when it determined the issue of obviousness by requiring a new and surprising result.[4]

Sperry Rand asserts that a significant new result or mode of operation was obtained in the '643 patent by increasing the speed of the rolls relative to the raking reel, which "accelerated and attenuated" the cut crop material and prevented it from bunching and piling up in front of the rolls. The acceleration and attenuation of crop material was not specified in the patent claims and the district court properly refused to consider that process as a significant advance over prior art. *See Graham* v. *John Deere Co., supra,* 383 U.S. at 25.

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[4] We find no support in this case for Sperry Rand's attempted distinction between a new combination of old functions, assertedly struck down in *A & P Tea,* and a combination of old *parts,* which may be viewed with greater liberality if it produces a new result. Sperry Rand correctly cites Reeves Instrument Corp. v. Beckman Instruments, Inc., 444 F.2d 263 (9th Cir.), *cert. denied,* 404 U.S. 951 (1971), for the proposition that the court must consider the combination "as a whole" and not the individual novelty of its separate elements. That decision, however, did not signal any retreat from the "unusual and surprising" results test for obviousness in any combination, whether of functions or of parts. *See id.* at 270-73. The district court in this case applied that test to determine that any increased efficiency of the Haybine was the obvious result of substituting well-known elements of farm machinery into an old combination.

Sperry Rand complains about the trial court's refusal to consider evidence of Deere's copying, the Haybine's commercial success and failure of the prior art in meeting an unsolved need as indicia of lack of obviousness. However, such secondary considerations cannot be the basis for validating a patent which, as here, is lacking in invention. *Hewlett-Packard Co.* v. *Tel-Design, Inc., supra,* 460 F.2d at 630-31.

Without claiming that the findings of fact are clearly erroneous, Sperry Rand discusses at great length the evidence underlying the district court's finding that the Haybine device was constructed with the use of old elements and functions known in the prior farm machinery art. We cannot hold this finding to be clearly erroneous. Since the proper test of obviousness was used, we must affirm the district court's conclusion that the '643 patent is invalid in view of prior art.

AFFIRMED.

B. Judgment of the Court of Appeals

UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

No. 71-1897

DC# F-306

DEERE & COMPANY,

Plaintiff-Appellee,

v.

SPERRY RAND CORPORATION,

Defendant-Appellant.

APPEAL from the United States District Court for the Eastern District of California (Fresno).

THIS CAUSE came on to be heard on the Transcript of the Record from the United States District Court for the Eastern District of California and was duly submitted.

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court, that the judgment of the said District Court in this Cause be, and hereby is AFFIRMED.

Filed and entered March 31, 1975.

C. Order of Court of Appeals on Rehearing

UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

No. 71-1897

DEERE & COMPANY,

Plaintiff-Appellee,

vs.

SPERRY RAND CORPORATION,

Defendant-Appellant.

Filed May 30 1975

ORDER

Before:

TRASK and WALLACE, *Circuit Judges,*
and KELLEHER,* *District Judge.*

The panel as constituted above has voted to deny the petition for rehearing. Judges Trask and Wallace have voted to reject the suggestion for rehearing en banc and Judge Kelleher has recommended that the suggestion for rehearing en banc be rejected.

The full court has been advised of the suggestion for an en banc hearing and no judge of the court has requested a vote on the suggestion for rehearing en banc. Fed. R. App. P. 35(b).

The petition for rehearing is denied and the suggestion for rehearing en banc is rejected.

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* Honorable Robert J. Kelleher, United States District Judge, Central District of California, sitting by designation.

D. The District Court's Memorandum Opinion

IN THE

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF CALIFORNIA

Civ. No. F-306

DEERE & COMPANY,

Plaintiff,

vs.

SPERRY RAND CORPORATION,

Defendant.

(Filed Dec 7 1970)

MEMORANDUM AND ORDER

This is an action for a declaratory judgment under 28 U.S.C. § 2201 by which plaintiff asks that certain of defendant's patents be declared invalid and not infringed by plaintiff. These patents are Glass, No. 3,325,981, McCarty, No. 3,375,643, Glass, No. 3,383,844, and Glass, No. 3,386,233. Plaintiff also asks that this court hold that defendant is estopped to assert infringement of the Glass patent Nos. 3,383,844 and 3,386,233. Defendant counterclaims for an injunction against infringement of certain claims of the above designated patents by plaintiff. The case was tried before this court without a jury.

At trial defendant offered evidence of infringement on the following ten claims. Claims 13, 16 and 20 of the McCarty patent No. 3,375,643 (hereinafter referred to as the '643 patent); claim 6 of the Glass patent No. 3,325,981

(hereinafter referred to as the '981 patent); claim 8 of the Glass patent No. 3,383,844 (hereinafter referred to as the '844 patent); and claims 1 and 5 of the Glass patent No. 3,386,233 (hereinafter referred to as the '233 patent). Since all of the claims of the subject patents are invalid as a result of the evidence presented at trial by plaintiff, the question of infringement is not reached.

Plaintiff and defendant's New Holland Division are companies competing with each other as well as several other large companies in the manufacture of agricultural equipment. Both parties have marketed hay harvesting machines in direct competition with each other. The plaintiff's machines are marketed under the designations Model 480 and 483 and the New Holland machine under the name "Haybine." The descriptive name commonly used in reference to both companies' machines is "mower-conditioner." They are designed to cut a hay crop such as alfalfa, to condition the crop material by passing it between two rolls so as to crack the stems of each plant, and to discharge the conditioned crop material in a windrow or a swath for drying in one continuous operation. The machines have been well received in the market.

The burden of proof in a declaratory judgment action involving patent infringement is on the defendant owner of the patents at issue. He has the burden of proving validity and infringement just as if he were the plaintiff suing for infringement of those patents. 6 A Moore's Federal Practice § 57.31[2], p. 3158; *Philip A. Hunt Co.* v. *Mallinckrodt Chemical Works,* 72 F.Supp. 865 (E.D.N.Y. 1947); *Purer & Company* v. *Aktiebolaget Addo,* 410 F.2d 871 (9th Cir. 1969).

Normally, however, there is a statutory presumption of validity of the patents in suit. 35 U.S.C. § 282; *Steven-*

son v. *Diebold, Incorporated,* 422 F.2d 1228 (9th Cir. 1970). A judicially imposed limitation on this presumption exists where pertinent prior art was not considered by the Patent Office in granting the patent. In this situation the presumption is at least weakened if not overcome. *Aerotec Industries of Calif.* v. *Pacific Scientific Company,* 381 F.2d 795, 803 (9th Cir. 1967); *Ellicott Mach. Corp.* v. *United States & American M.&M. Co.,* 405 F.2d 1385, 1392 (Ct. Cl. 1969).

Plaintiff Deere & Company challenges the validity of the patents in suit on grounds of anticipation by prior art not before the Patent Office, prior public use, prior public sale, and lack of invention.

The McCarty Patent No. 3,375,643

Since the '643 patent constitutes the primary patent in suit, it is considered first. This patent has twenty-seven claims covering a mower-conditioner substantially identical to the New Holland Haybine machine. With respect to the invalidity of the '643 patent, plaintiff relies primarily on the existence of one prior art machine which, it is agreed, was not considered by the Patent Office. The machine is the Crose hay harvester (hereinafter referred to as the Crose machine).

Uncontradicted evidence produced at trial, including one actual Crose machine, indicated that six Crose machines were manufactured and sold in 1956 and one in 1958 by the H. L. Crose Company of Tulare, California. The '643 patent was filed in 1964. While information as to the subsequent use of some of the Crose machines is lacking, the machine produced at trial was operated for a period of several years by its owner. He made his

living during those years mowing and conditioning hay for growers using the Crose machine.

It is agreed that the ultimate object of the use of conditioning rolls in the two machines is somewhat different. The rolls of the Crose machine are designed to wring moisture out of the plants. On the other hand, the rolls disclosed in the '643 patent are designed to crack the stems of the plants passing between them so that water can escape more readily during the drying period. It is also designed to avoid damaging the leaves of the plants since moisture is dispersed through the pores of the leaves. Yet, this functional distinction is not of patentable significance since many prior art devices have employed this technique of conditioning.

It is conceded by defendant that the elements claimed in this patent are old. It is contended, however, that they form a new patentable combination by virtue of their unique mode of operation. It is assumed that the Patent Office considered the combination to be new when compared with the prior art before it. Therefore, the issue is whether or not the Crose machine anticipates the allegedly new combination appearing in the claims of the '643 patent.

The asserted patentable distinctions between the device of the '643 patent and the Crose machine are relatively few. The '643 device is a pull-type machine (specifically covered in claims 19, 20, 21 and 22), but the Crose machine is self-propelled. The '643 machine has an aggressive upper roll (specifically covered by claims 5, 15, 16, 17, 18, 19, 20, 21, 22, 25 and 26), but the Crose machine does not. The '643 machine has a reel with cam actuated tines (specifically covered by claims 6, 7, 8, 9, 10 and 16), but the tines of the Crose machine are not cam actuated.

The speed of the rolls is faster than that of the reel in the '643 device (specifically covered in claims 1, 2, 3, 4, 5, 14, 15, 16, 17, 18, 19, 20, 23, 24, 25 and 26), but this is true of the R.P.M. speed of the Crose machine. The upper roll of the '643 device is positioned slightly ahead of the lower roll (specifically covered by claims 2, 4, 10, 18 and 26), but this is not true of the Crose machine.

Defendant argues that the new and surprising result achieved by this new combination is that the machine clogs or plugs with crop material much less frequently than heretofore has been the case with mower-conditioners and that it is able to handle more types of hay crops. Defendant asserts that their machine accelerates the crop material as it passes through the machine thereby attenuating the material so as to provide more uniform conditioning without plugging of the device. Defendant says that this accounts for the economic success of the Haybine machine as opposed to the Crose machine.

However, nowhere, either in the claims or the specification of the '643 patent, is this new result or mode of operation involving acceleration and attenuation mentioned. Consequently, this argument cannot be relied upon to validate the patent. *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545, 550 (1938); *Graham* v. *John Deere Co.*, 383 U.S. 1, 25 (1966). The only language which arguably could support the validity of some of the claims of the patent is that appearing in claim 14, among others, and seeming to be the essence of the invention as patented. Claim 14 at line 61 states: . . . "and means rotating said rolls faster than said reel to strip crop material from said tine members." The specification and several of the other claims state that this stripping action permits uniform conditioning of the crop material without clogging of the machine.

Assuming that the '643 device does so operate, the Crose machine anticipates the '643 device and any perfection of technique over the Crose machine is accomplished by means which would have been obvious to a person skilled in the art. It does not constitute patentable invention. 35 U.S.C. §§ 102, 103.

Both parties to this suit agree that the Crose machine is the most important prior art discovered and that it was not considered by the Patent Office in granting the '643 patent. The Crose machine affords a raking reel, cutter bar, guide ramp, conditioning rolls, and the other key elements of the '643 device mounted in the frame in substantially the same operational relationship. This prior art machine clearly anticipates this basic combination. 35 U.S.C. § 102. Proof of the fact that it operates successfully as a mower-conditioner appears in the uncontradicted testimony that it was used in a business relationship for a number of years.

The only distinctions relied upon by defendant are those already recited which admittedly are old. Where an invention is comprised of old elements, the combination must result in new and surprising consequences and not merely produce a result consistent with the expected operation of the sum of the constituent elements. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147 (1950). This test for obviousness has been held applicable with particular strictness to mechanical combinations. *Hensley Equipment Company* v. *Esco Corporation*, 375 F.2d 432, 436-437 (9th Cir. 1967). Mere improvement of performance is not sufficient. *Altoona Theatres* v. *Tri-Ergon Corp.*, 294 U.S. 477, 486 (1935); *Wham-O-Mfg. Co.* v. *Paradise Manufacturing Co.*, 327 F.2d 748, 750 (9th Cir. 1964). The '643 device is an improvement over the Crose machine in that

it does not clog with crop material as frequently. However, this is not a new and surprising result. It is an improvement accomplished by the obvious method of selecting proven elements from known prior art devices. This is not patentable invention and the fact that the Haybine has been a commercial success does not make it so. *Dymo Industries, Inc.* v. *Com-Tech, Inc.*, 391 F.2d 335, 345 (9th Cir. 1968). All the claims have been considered on an individual basis and nothing of patentable significance was found when reviewed in light of the above discussed prior art. Therefore the '643 patent is invalid.

The Glass Patent No. 3,325,981

The '981 patent claims a mower-conditioner of the type disclosed by the '643 patent having the combination of a right angled gearbox and a counterbalancing spring which cooperate to provide power for the floating header of the machine so as to allow it to operate while the header follows the contour of the ground as the machine is pulled through the field. The essence of the invention is that the power output shaft of the gearbox is coaxial with the pivot axis of the header. Defendant again argues that although the individual elements are old, it is a new combination producing a new and surprising result. To the contrary, this invention is anticipated by the prior art patent placed in evidence by plaintiff. Since it was not considered by the Patent Office in granting the '981 patent, the presumption of validity normally applying to a patent is weakened as previously discussed. *Aerotec.*

This prior art is the Johnson Patent No. 2,924,466 owned by plaintiff. The Johnson patent has one claim covering an adjustable draft member. However, the device is shown

in the drawings and described in the specification for use on a windrower. The windrower affords a drive shaft which is coaxial with the pivot axis of what is termed a "platform" on which a cutter bar is mounted. The cutter bar is driven from the drive shaft. This "platform" corresponds to the header of the '981 patent. The "platform" is connected to counterbalance springs substantially as in the '981 patent to help maintain the "platform" in floating relation.

Several distinctions are noted. The Johnson patent does not actually show a right angled gearbox and the arrangement for driving the cutter bar off the coaxial drive shaft is not precisely as that disclosed in the '981 patent. Yet, these distinctions are not of significance. As the testimony at trial indicated the most conventional manner for powering the drive shaft as disclosed in the Johnson patent would be through a right angled gearbox. Furthermore, there is no claimed advantage in using the specific arrangement of the '981 patent for driving the cutter bar from the coaxial drive shaft. The designs are clearly equivalent. Finally, the fact that the Johnson "platform" is not intended actually to ride along the contour of the ground, but is designed to be adjusted by the operator during use is not significant since the basic structural designs are the same. This operative design difference is merely a matter of preference. There is no patentable significance in the combination of the mower-conditioner of the invalidated '643 patent with the main feature of the '981 patent.

A study of the seven claims of this patent has failed to disclose any basis other than that discussed above upon which the patent could be held valid. Consequently, we hold the '981 patent to be invalid as anticipated by the prior art.

The Glass Patent No. 3,383,844

The '844 patent comprises eleven claims covering a mower-conditioner of the type appearing in the '643 patent in combination with an arrangement of windrow shields mounted at the discharge end of the machine so as to deflect conditioned crop material, discharged from the rolls at relatively high speed, into a windrow or a swath as desired. Defendant relies on claim 8 which claims the combination of the mower-conditioner and the windrow shields. Defendant contends that the unique combination of the relatively high speed discharge of crop material from the conditioning rolls coupled with the positioning of the shields enables the device to consolidate a nine-foot swath of discharged crop material into a three-foot windrow without the use of an auger or similar aid. Nowhere in the '844 patent is this contention mentioned and all that is discussed or claimed is the combination.

This combination is not patentable. It is not contested that the use of windrow shields as disclosed in the '844 patent is old. The Oppel patent No. 2,992,523 and the other references cited by the Patent Office in granting the subject patent illustrate this fact. The claimed new result of consolidating a wide swath into a narrow windrow using this combination of old elements is the obvious result of their combination. The fact that the Crose machine used an auger does not militate against this result.

The claims have been reviewed in detail and there is no basis upon which validity could be established in view of the above discussion. Consequently, the '844 patent is invalid.

The Glass Patent No. 3,386,233

The '233 patent is the last of the patents in suit comprising fourteen claims and relating to an implement frame for use in a mower-conditioner such as that shown by the '643 patent. The structure of the frame in the claims is L-shaped. It provides a tapered longitudinal beam which is rectangular in cross section and extends in a horizontal attitude rearwardly of the operative elements of the mower-conditioner. Defendant argues that this is a patentable combination having the new and surprising result of affording a lightweight, strong, torsion resistant frame which is above the conditioning rolls so as not to interfere with the discharge of crop material from the rolls. The patent makes no statement, either in the specification or the claims, about being torsion resistant.

The plaintiff again presents a prior art patent not considered by the Patent Office in arguing invalidity of the subject patent. This patent is the Korsmo patent No. 2,071,844. It discloses a windrow harvester having an L-shaped frame with a horizontal, tapered frame member which is above and to the rear of the operative elements of the device. Other portions of the frame do, however, extend below the horizontal, tapered frame member. The testimony at trial indicated that the Korsmo patent reads on the '233 patent and would structurally be as strong although possibly not as resistant to torsion. What differences may exist between the Korsmo patent frame and the '233 patent frame are differences only of form and not substance, and of no patentable significance in the combination of the frame with the specific mower-conditioner claimed.

All of the claims of this patent have been carefully considered on an individual basis. None of the claims cover anything of patentable significance when viewed in light of the above discussed prior art. Therefore, this patent is invalid.

Evidence was produced at trial indicating that plaintiff had copied the defendant's Haybine machine in producing its mower-conditioners. This evidence, of course, goes to the issue of infringement of the patents in suit. Validity of those patents cannot be made to rest on such evidence. *Jeddeloh Brothers Sweed Mills, Inc.* v. *Coe Manufacturing Co.*, 375 F.2d 85, 92 (9th Cir. 1967).

Judgment is granted to the plaintiff as prayed, and plaintiff is to prepare and lodge findings of fact, conclusions of law and judgment in accordance with the Local Rules of this court.

The clerk of this court is directed to serve copies of this order by United States mail upon the attorneys for the parties appearing in this cause.

/s/ M. D. Crocker
United States District Judge